

### **REMARKS**

The Applicant hereby traverses the objection and rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 1-18 have been cancelled and claims 19-51 have been added. Claims 19-51 are pending in this application.

#### **Amendments to the Specification**

The current application explicitly incorporates by reference U.S. Patent Application No. 09/671,571 and U.S. Patent Application No. 09/734,949 (now U.S. Patent Application Publication No. 2002/0072982). *See* paragraph [0002]. The material added in the “Amendments to the Specification (new paragraphs [0037]-[0094]),” is found in each of the applications incorporated by reference. As such, no new matter has been added.

#### **Claim Objections**

Claim 1 is objected to based on an informality. Please note that claim 1 has been cancelled.

#### **Rejection Under 35 U.S.C. § 112(1)**

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as being non-enabling. In rejecting claims 1 and 10, the Examiner opines “the specification does not identify any of the ‘plurality of parameters’ nor does the specification disclose how many parameters are processed nor does the specification disclose the process whereby the plurality of parameters are converted into a fingerprint/landmark. *See* Current Action, pg. 3. Please note that claims 1 and 10 have been cancelled. However, some of the newly added claims recite “a plurality of characteristics.” Support for this limitation and the information sought by the Examiner can be found, at least at paragraphs [0044], [0046], [0048], [0050], [0052], [0055], [0057], [0058], [0061] of the current application, Appendix I of U.S. Patent Application No. 09/671,571, and Appendix I of U.S. Patent Application No. 09/734,949.

In rejecting claims 8 and 17, the Examiner opines “the specification does not provide a clear and concise description of the claimed media which includes a file which is stored on a user’s computer.” *See* Current Action, pg. 9. Please note that claims 8 and 17 have been cancelled. However, Applicant points out that the information sought by the Examiner is disclosed in U.S. Patent Application No. 09/734,949 at, for example, paragraphs [0012], [0013], [0025], [0027], [0033], [0048], [0051], and [0058].

**Rejection Under 35 U.S.C. § 112(2)**

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In rejecting claim 1, the Examiner states “claim 1 provides for the use of a recognition process, but, since the claim does not set forth any steps involved, it is unclear what applicant is intending to encompass.” *See* Current action, pg. 4. As mentioned, claim 1 has been cancelled. The newly added claims are drawn to a method of creating a database. The database is, in particularly useful applications, envisioned as being used in a recognition process. As such, Applicant points out that breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if the applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. *See* M.P.E.P. § 2173.04. In the case at hand, the claims are drawn to creating a database, which may be used in a media recognition system. Such a recognition system is disclosed, for example, in U.S. Patent Application No. 09/671,571 and U.S. Patent Application No. 09/734,949. As such, the claims are definite when read in light of the specification.

**Rejection Under 35 U.S.C. § 101**

Claims 1-18 are rejected under 35 U.S.C. 101 for resulting in a “claim which is not a proper process claim under 35 U.S.C. 101.” *See* Current Action, pg. 5. In rejecting the claims, the Examiner opines “the method of recognizing the known media sample from ‘processed’ parameters, i.e., fingerprints/landmarks, is not described in the specification.” Again, claims 1-18 have been cancelled; however, some of the newly added claims recite “fingerprint/landmark pairs.” Support for this limitation and the information sought by the

Examiner can be found, at least at paragraphs [0044], [0046], [0048], [0050], [0052], [0055], [0057], [0058], [0061] of the current application, Appendix I of U.S. Patent Application No. 09/671,571, and Appendix I of U.S. Patent Application No. 09/734,949.

**Rejection Under 35 U.S.C. § 102(e)**

Claims 1-4, 6, 7, 10-13, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,505,160 to Levy et al (hereinafter "Levy").

It is well settled that to anticipate a claim, the reference must teach every limitation of the claim. *see* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he limitations must be arranged as required by the claim." *see* M.P.E.P. § 2131; citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *see* M.P.E.P. § 2131; citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claims 1-18 have been cancelled. Nevertheless, Applicant points out that Levy does not teach every limitation of the pending claims. For instance, claim 19 recites "processing said characteristics into fingerprint/landmark pairs." Levy discloses a way to associate an identifier with a corresponding audio signal by deriving that identifier from the signal. *See* Levy col. 9 lines 40-43. Levy further discloses that a decoder computes a fingerprint, which is a number derived from a digital audio signal that serves as a statistically unique identifier of that signal, "meaning there is a high probability that the fingerprint was derived from the audio signal in question." *See* Levy col. 9 lines 48-53. As such, Levy merely speaks to a single fingerprint used as an identifier associated with an audio signal. However, Levy does not speak to computing more than one fingerprint, much less "fingerprint/landmark pairs." Instead, Levy suggests that a single fingerprint, and only a single fingerprint, is used in its invention. For instance, at col. 10 lines 1-3, Levy discusses using a fingerprint to select an appropriate watermark decoding system for a signal. Put simply, Levy discloses a fingerprint, but wholly fails to teach fingerprint/landmark pairs.

Claim 19 further recites “storing said landmark/fingerprint pairs in said database.” As mentioned above, Levy is wholly silent as to fingerprint/landmark pairs. Further, Levy merely discloses a registration process that provides an identifier and “stores a database record of the association between the identifier and the object or other information used in decoding to identify the object, such as its distributor or broadcaster.” *See* Levy col. 4 lines 2-6. Applicant respectfully submits that merely providing an identifier and storing a record of the association between that identifier and other information is not the same as storing fingerprint/landmark pairs. Even if Levy’s identifier could be construed as a fingerprint, which in this context Applicant asserts that it could not, Levy is wholly silent as to landmarks, much less fingerprint/landmark pairs. Simply, Levy fails to teach storing fingerprint/landmark pairs in a database as recited in claim 19.

Claims 20-30 depend from claim 19 and inherit every limitation therefrom. As such, claims 20-31 set forth limitations not taught by Levy. Therefore, 20-30 are patentable at least for the reasons set forth above with respect to claim 19.

**Rejection Under 35 U.S.C. § 103(a)**

Claims 5 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Levy in view of U.S. Patent No. 6,292,185 to Ko et al (hereinafter “Ko”).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding that the first or second criteria is satisfied, the Applicant respectfully asserts that the Examiner’s rejection fails to satisfy the third criteria.

As mentioned above, claims 5 and 14 have been cancelled. Nevertheless, as shown above, Levy fails to teach or suggest “processing said characteristics into fingerprint/landmark pairs” and “storing said landmark/fingerprint pairs in said database” as recited in claim 19. Also, Ko is not relied upon to teach or suggest these missing limitations.

As such, the Examiner's proposed combination fails to teach or suggest each limitation of Applicant's invention.

**Conclusion**

In view of the remarks above, the Applicant believes the pending application is in condition for allowance. The Applicant believes no additional fee is due with this response, other than that addressed in the accompanying fee transmittal. However, if an additional fee is due, please charge our Deposit Account No. 06-2380, under Order No. 69323/P004US/10511468 from which the undersigned is authorized to draw.

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Respectfully submitted,

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